



UNITED STATES PATENT AND TRADEMARK OFFICE

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In re application of
Strauven et al.

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Serial No. 09/936,531

:

DECISION ON
PETITION

Filed: September 11, 2001

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For: Centrifugally Atomized Zinc Alloy Powder For
Alkaline Batteries

This is a response to the PETITION TO WITHDRAW HOLDING OF ABANDONMENT, filed June 23, 2005. The petition requests that the abandonment, as set forth in the Notice of Abandonment of June 13, 2005 for failure to timely file a proper response to the Final Rejection of October 14, 2004, be withdrawn. The petitioner asserts that an RCE was timely filed on February 14, 2005. However, the Office issued a Notice of Improper RCE on May 10, 2005, which is after the allowable extension of time period had expired from the date of the Final Rejection and that until this time, the applicant was unaware that there was anything deficient with the RCE request. The applicant promptly filed a proper submission for the RCE upon receipt of the Notice of Improper RCE.

DECISION

The instant request is accepted as a timely petition under 37 C.F.R. 1.181 (no fee). A review of the evidence provided by the applicant and a review of the USPTO application file establishes that the request cannot be granted. As clearly stated in the Notice of Improper RCE, mailed May 10, 2005, the RCE "request was not accompanied by a submission as required by 37 CFR 1.114. Since the application is not under appeal, the time period set forth in the final Office action or notice of allowance continues to run from the mailing date of that action or notice." Since the applicant did not file a proper submission within the time period allowed from the mailing date of the final Office action, the instant application is considered abandoned. Furthermore:



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37 C.F.R. § 1.113 states:

“37 C.F.R. § 1.113 (a) Final rejection or action.

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicants, or for *ex parte* reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 1.191), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Commissioner in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an *inter partes* reexamination filed under § 1.913, see § 1.953.” (emphasis added)

37 C.F.R. § 1.114 states:

“37 CFR § 1.114 Request for continued examination.

(a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in § 1.17(e) prior to the earliest of:

- (1) Payment of the issue fee, unless a petition under § 1.313 is granted;
- (2) Abandonment of the application; or
- (3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.

(b) Prosecution in an application is closed as used in this section means that the application is under appeal, or that the last Office action is a final action (§ 1.113), a notice of allowance (§ 1.311), or an action that otherwise closes prosecution in the application.

(c) A submission as used in this section includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. If reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of § 1.111.

(d) If an applicant timely files a submission and fee set forth in § 1.17(e), the Office will withdraw the finality of any Office action and the submission will be entered and considered. If an applicant files a request for continued examination under this section after appeal, but prior to a decision on the appeal, it will be treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner. An appeal brief under § 1.192 or a reply brief under § 1.193(b), or related papers, will not be considered a submission under this section.

(e) The provisions of this section do not apply to:

- (1) A provisional application;



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- (2) An application for a utility or plant patent filed under 35 U.S.C. 111(a) before June 8, 1995;
- (3) An international application filed under 35 U.S.C. 363 before June 8, 1995;
- (4) An application for a design patent; or
- (5) A patent under reexamination"

37 C.F.R. § 1.116 (b) states:

"37 CFR § 1.116 Amendments after final action or appeal.

(b) After a final rejection or other final action (§ 1.113) in an application or *ex parte* reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an *inter partes* reexamination filed under § 1.913, amendments may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under § 1.135, or the reexamination from termination. No amendment can be made in an *inter partes* reexamination proceeding after the right of appeal notice under § 1.953 except as provided for in paragraph (d) of this section." (emphasis added)

Due to the fact that applicants request filed February 14, 2005 was not accompanied by a submission as required by 37 CFR 1.114 and since the application was not under appeal, the time period set forth in the final Office action continued to run from the mailing date of the final rejection of October 14, 2004. Since the time period set forth in the final Office action continued to run from the mailing date of the final rejection of October 14, 2004, the application became abandoned by operation of law on April 14, 2005 because applicant did not file a proper reply to the final Office letter mailed October 14, 2004. Therefore, given the finality of the rejection in the instant application, the only courses of action available to the applicant as the end of the 6-month statutory period approached would have been:

- (1) To file an amendment with the proper extension of time fee, under 37 C.F.R. 1.116, which placed the application in condition for allowance, see MPEP 706.07(f);
- (2) File a notice of appeal with the proper extension of time fee, see MPEP 1205;



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- (3) File a request for continued examination (RCE) filed under 37 CFR 1.114 with a submission (i.e., an amendment that meets the reply requirement of 37 CFR 1.111) and the fee set forth in 37 CFR 1.17(e). RCE practice under 37 CFR 1.114 does not apply to utility or plant patent applications filed before June 8, 1995 and design applications.
- (4) File a continued prosecution application (CPA) under 37 CFR 1.53(d), if appropriate. See MPEP § 201.06(d). **CPA practice does not apply to utility or plant applications if the prior application has a filing date on or after May 29, 2000.** See MPEP § 706.07(h), paragraphs I and IV.
- (5) Abandon the application.

While the Office attempts to promptly respond to an amendment or papers filed after final, there are those instances where delays do occur, as in the instant application. However, it is clear from rule 37 C.F.R. 1.113 and 1.116 that abandonment of an application is risked when an amendment or other filing after a final Office action is proffered by the applicant. The rule clearly indicates that the mere filing of an amendment or other filing does not relieve petitioner of the duty of taking appropriate action to save the application from abandonment. Therefore, whether or not petitioners request for RCE was received and processed prior to the expiration of the six-month statutory period, the only right petitioner was entitled to was that of appealing the final rejection or filing a proper request for continued examination. This application became abandoned for failure on the part of petitioner to file an appeal or a proper request for continued examination. This application became abandoned by operation of law (35 U.S.C. 133) for applicants' failure to timely file a Notice of Appeal or proper request for continued examination in response to the outstanding final rejection. See Lorenz v. Finkl, 333 F.2d 885, 891, 142 USPQ 26, 30 (CCPA 1964).

The applicants are advised that if a petition under 37 C.F.R. 1.137(a) or (b) is filed, then such a petition should be accompanied by a:

- (1) **NOTICE OF APPEAL** and pay the required notice of appeal fee, which is set by 37 C.F.R. 1.17(e). An appeal brief would be due two (2) months from the date of filing the notice of appeal, but the due date can be extended up to five (5) months with payment of extension of time fees, or a;



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(2) Request for continued examination under 37 C.F.R. 1.114 with the appropriate filing fee and submission required by the rule, and a;

(3) Terminal Disclaimer, pursuant to 37 C.F.R. 1.137(c).

Therefore, the Notice of Abandonment is not withdrawn.

The Petition is **DISMISSED**.

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